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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/606,962

06/27/2003

Seiji Horie

019519-395

4849

7590 02/27/2007  
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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/606,962

Applicant(s)

HORIE ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### **Claim Rejections - 35 USC § 103**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (U.S. 6,197,847) in view of either EP 1205815 or Adams (U.S. 2002/0147252).

The rejection is adequately set forth in paragraph 4 of the office action mailed 8/28/06 and is incorporated here by reference.

#### **Response to Arguments**

3. Applicants' arguments filed 11/28/06 have been fully considered but they are not persuasive.

Specifically, applicants argue that there is no motivation to combine Kato et al. with EP 1205815 or Adams et al. given that EP 1205815 and Adams et al. each relate to ink compositions that are distinct from the ink of Kato et al.

However, while the ink of EP 1205815 or Adams et al. is not identical to the ink of Kato et al., it is noted that both EP 1205815 and Adams et al. disclose the use of surface-treated pigment in oil-based or non-aqueous inks and that the ink of Kato et al. is also oil-based. Further, Adams et al. disclose the use of the surface-treated pigment in core/shell particles, i.e. pigment surface treated with polymer, i.e. core, which is then coated with another polymer, i.e. shell.

Thus, given that EP 1205815 and Adams et al. are each drawn to the same field of endeavor as Kato et al., i.e. oil-based ink, given that EP 1205815 and Adams et al. each disclose surface-treated pigment as presently claimed, and given that EP 1205815 and Adams et al. each disclose motivation for using such surface-treated pigment, it is the examiner's position that the combination of Kato et al. with EP 1205815 or Adams et al. is proper.

Applicants also argue that the advantages of using surface-treated pigment disclosed by EP 1205815 or Adams et al. are with respect to the particular inks disclosed in EP 1205815 or Adams et al.

However, the courts have held that "the motivation to combine can arise from the knowledge that the prior art elements will perform their expected functions to achieve their expected results when combined for their common purpose." *Miles Lab, Inc. v. Shandon Inc.* 997 F.2d at 878, 27 USPQ 2d 1123, 1128 (Fed.Cir. 1993). Based on the teachings of EP 1205815 or Adams et al., one of ordinary skill in the art would have recognized that surface-treated pigment functions so as to improve dispersability and charge characteristics (EP 1205815) or to produce ink with good dispersion stability, printability, and print performance (Adams et al.) in oil-based ink and would have expected such surface-treated pigment to function as such in other inks.

Applicants also argue that the declaration filed 11/28/06 establishes that unexpected or surprising results can be attained by employing the oil-based ink of the present invention.

The declaration compares ink with the scope of the present claims with oil-based ink Ik-1 of Kato et al., ink of example 5 of EP 1205815, and ink of example 4 of Adams et al. It is shown that the ink of the present invention is superior in terms of scratch resistance.

However, it is the examiner's position that the declaration is not persuasive for the following reasons.

Kato et al. disclose oil-based ink for ink jet printer wherein the ink comprises pigment, i.e. core, contained in resin particles, i.e. shell, wherein the resin is obtained by dispersion polymerization of two monofunctional monomers which are dispersed in non-aqueous solvent in presence of dispersion stabilizer and polymerization initiator. It is disclosed that one monomer contains fluorine atom. However, there is no disclosure that the pigment is surface treated, which is why Kato et al. is combined with EP 1205815 or Adams et al.

Comparative example 1 of the declaration, which corresponds to oil-based ink Ik-1 of Kato et al., not only does not comprise surface treated pigment as presently claimed, the resin of the shell of the core/shell polymer is not obtained from monofunctional polymerizable (B) having substituent-containing silicon and/or a fluorine atom as presently claimed. However, Kato et al. do disclose that the resin is obtained from monomer that contains fluorine. While applicants have chosen example wherein such monomer is not utilized, this is only one preferred embodiment of Kato et al. A fair reading of the reference as a whole disclose that the resin (shell) of Kato et al. is in fact obtained from fluorine-containing monomer (col.8, line 38 and col.16, line 30).

Thus, the declaration does not compare the ink of the present invention with ink of the "closest" prior art, namely, Kato et al.

Further, the rejection of record discloses that the difference between Kato et al. and the present claimed invention is the requirement in the claims of surface-treated pigment. However, there is no showing in the declaration regarding the criticality of using such surface-treated

pigment, That is, there is no comparison between inks within the scope of the present claims, i.e. oil-based ink comprising colored resin particles comprising core/shell particles that comprise core comprising pigment subjected to surface treatment and shell layer coating the core wherein the core/shell particles are obtained from monomers (A) and (B) and ink outside the scope of the present claims but within the scope of the prior art, i.e. oil-based ink comprising colored resin particles comprising core/shell particles that comprise core comprising pigment (not surface treated) and shell layer coating the core wherein the core/shell particles are obtained from monomers (A) and (B).

Further, while the declaration shows that the ink of the present invention is superior in terms of scratch resistance as compared to ink of EP 1205815 (comparative example 2) or ink of Adams et al. (comparative example 3), note these references are only used as teaching references, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teaches a certain concept, namely, the use of surface-treated pigment in ink in order to improve dispersability and charge characteristics (EP 1205815) or to produce ink with good dispersion stability, printability, and print performance in oil-based ink (Adams et al.) and in combination with the primary reference, discloses the presently claimed invention.

In light of the above, it is the examiner's position that the declaration is not persuasive.

Thus, the rejection of record remains relevant against the present claims.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

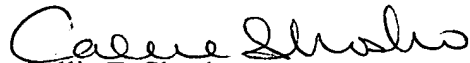
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
2/16/07